



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/240,895	05/11/94	COMISKEY	S 17234

15M2/0727
NIXON & VANDERHYE
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EXAMINER MACHOLLE, M

ART UNIT	PAPER NUMBER
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1513

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DATE MAILED: 07/27/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.
Of the above, claims 3-5, 14, 15 and 20 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 2, 6-13 and 16-19 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-20 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. The application is objected to because of alterations which have not been initialed and dated as is required by 37 CFR 1.52(c) and 1.56.

A properly executed affidavit or declaration signed by all of the inventors identifying the alterations and stating when the unsigned and undated alterations were made is required.

If the alterations were made *before* the signing of the oath or declaration, a new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by its Serial Number, filing date and title is also required.

If the alterations were made *after* the signing of the oath or declaration, a full explanation and cancellation of such alterations is required.

2. This application contains claims directed to the following patentably distinct species of the claimed invention: species 1 - stencil/eye black; species 2 - decal; species 3 - temporary tatoo.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2 and 8-13 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R.

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§ 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

3. During a telephone conversation with Mr. Robert Vanderhye on 07/07/94, a provisional election was made without traverse, in accordance with MPEP 708.02(VIII), to prosecute the invention of species 3 directed to a temporary tattoo, claims 6, 7 and 16-19. Affirmation of this election must be made by applicant in responding to this Office action. Claims 3-5, 14, 15 and 20 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to the non-elected species.

4. Claims 1, 2, 6-13 and 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: Proper antecedent basis is lacking for "the non-reflective material" (line 10). The phrases "generally covering" and "location...at which...light is likely to be reflected" are vague and indefinite. Is there a minimum amount of area covered

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in order to be considered as "generally covering"? Is there any difference in location for reflection of direct light vs. reflection of indirect light?

Claim 2: The phrase "so that the material substantially eliminates reflection" is unclear. How much light could be reflected and still be considered to substantially eliminated? Is it possible for direct light to be reflected but not indirect light or vice versa? Is it the material composition which is responsible for substantially eliminating reflection? Is it the placement of the material responsible for substantially eliminating reflection?

Claims 8, 9 and 19: The limitation regarding size in compliance with regulations is indefinite.

Claims 9 and 10: It is unclear if the phrase "primarily black or dark colored" places any limitation with respect to amount of area. How much is "most" of the light?

Claim 17: The limitation of "dimensioned to substantially cover the area" is indefinite. The area to be covered will vary with the size of the person.

The limitation of "sufficient to substantially eliminate" is unclear. It is uncertain which factor must be sufficient (i.e. size of tatoo, amount or particular material used ...). See previous comments with regard to claim 2.

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Claim 18: The phrase "no part of the shape that is not a dull or matte black or dark color" is unclear. It is not positively recited in claim 17 or 18 that there is any portion that is a dull or matte black or dark color. What is within the scope of "significant reflection" and a "size significant enough"?

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 1, 2 and 8-12 are rejected under 35 U.S.C. § 103 as being unpatentable over the conventional use of eye black by athletes.

The use of eye black by athletes to minimize reflected light is old and is admitted as such on page 1 of the present specification. Applicants seek to distinguish the present

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claimed invention from this conventional practice by specifying that the non-reflective material is in the form of a "predefined clearly demarcated geometric shape which provides a non-verbal communication to others".

The conventional use of eye black provides a non-verbal communication in that someone seeing a person wearing eye black will likely come to the conclusion that the wearer is/was a participant in an athletic event.

The limitation with regard to "predefined clearly demarcated geometric shape" is not seen as patentably distinguishing the present invention from the conventional use of eye black. As seen on the Sports Illustrated cover submitted with applicants' Information Disclosure, the eye black reasonably appears to be "clearly demarcated" in that it is clear where the eye black is applied versus where it is not applied. The area of eye black has a "shape". The terms "predefined" and "geometric" do not place any clear positive limitations on the shape.

The application of eye black in a particular pattern/shape/design, as in claims 8-12, would be a matter of obvious design choice requiring only an expenditure of time, and possibly some artistic skill, on the part of the applier.

7. Claims 1, 2, 6-13 and 16-19 are rejected under 35 U.S.C. § 103 as being unpatentable over conventional temporary tattoos

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as exemplified by the Team Dynamics, J.B. Marketing, Inc., and Anderson's brochures supplied with applicants' Information Disclosure filed 05/11/94.

The basic structure of applicants' temporary tattoo and the method of applying the temporary tattoo were known at the time of the invention.

Applicants seek to distinguish the presently claimed invention from known temporary tattoos by stating that the tattoo is placed in the area of the eye. As applicants point out, the directions of the back of the temporary tattoos from J.B. Marketing, Inc. state that the tattoo should not be applied near eyes. However, both the Team Dynamics brochure and the J.B. Marketing, Inc. brochure show people with temporary tattoos applied as close to their eyes as would be applied in the present invention, based on the general disclosure of what is considered to be the reflective area.

With respect to claims 17-19, the intended use of the temporary tattoo does not patentably distinguish the claimed tattoo from known tattoos.

Applicants also seek to distinguish the presently claimed invention from known temporary tattoos by stating that the inventive tattoos comprise dull or matte black or dark colors. The advertising brochures show several black or dark color tattoos within the scope of the present invention's examples of

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"dark" colors. The pictures in the brochures appear to be shiny, however, it is uncertain whether the tattoos as applied would be shiny, particularly in consideration of the statement in the J.B. Marketing, Inc. brochure that the tattoos are "incredibly realistic...looks just like a real tattoo". Real tattoos generally have a matte appearance.

The brochures show temporary tattoos representing logos, team mascots and letters. The shape of the design for Figures 6 and 7 of the present application is shown in the Team Dynamics brochure, available in black as item A-64-8, and is shown in the "Anderson's" brochure, available as item 33A64.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kitabatake discloses transfer sheets and methods for application of designs to human skin.

Relyea discloses body tattoos comprising a printed image on a non-reflective, non-shiny substrate. The non-reflective substrate is desired so that the tattoo is less distinguishable as an imitation. The tattoos are said to conform well to convex surfaces such as cheeks.

Oschner is directed to an ultraviolet nose protector and teaches that the nose protector "can be of a flat non-reflective

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color if reflection of light rays into the eye is a consideration" (col. 3, lines 20-21).

9. **Crystal Mall 1 Fax Center**

A facsimile center has been established in Crystal Mall 1, room 7C03. The hours of operation are Monday through Friday, 8:30 AM to 4:30 PM. The telecopier numbers for accessing the facsimile machine are (703) 305-3596 and (703) 305-3612. This location should be used in all instances when faxing any correspondence to Group 150. Use of the Crystal Mall 1 center will facilitate rapid delivery of materials to the Group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

10. Any inquiry concerning this communication should be directed to Marie R. Macholl at telephone number (703) 308-4413. The examiner can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday-Thursday and on alternate Fridays.

MRM

M. Macholl
07/25/94


PATRICK J. RYAN
SUPERVISORY PATENT EXAMINER
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